

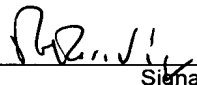
Doc Code: AP.PRE.REQ

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 61135/P012US/10105074	
	Application Number 08/953,477-Conf. #3876	Filed October 17, 1997	
	First Named Inventor Salim G. Kara et al.		
	Art Unit 2622	Examiner J. R. Pokrzywa	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div><div><input type="checkbox"/> applicant /inventor.</div><div><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div><input type="checkbox"/> attorney or agent of record. Registration number _____</div><div><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>42,203</u></div></div> <div><div> Signature</div><div>R. Ross Viguet Typed or printed name</div><div>(214) 855-8185 Telephone number</div><div>May 4, 2006 Date</div></div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<div><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>			



Docket No.: 61135/P012US/10105074
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Salim G. Kara et al.

Application No.: 08/953,477

Confirmation No.: 3876

Filed: October 17, 1997

Art Unit: 2622

For: POSTAGE SERVER SYSTEM AND METHOD

Examiner: J. R. Pokrzywa

**APPELLANT'S ARGUMENTS FOR
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Appellant hereby requests that a panel of Examiners formally review the legal and factual basis of the rejections of record prior to the filing of an Appeal Brief. This Request is filed with a Notice of Appeal.

REMARKS**I. Issues**

Is the 35 U.S.C. § 102 rejection of record proper?

II. Rejection under 35 U.S.C. § 102(e)

In the Office Action mailed January 17, 2006 (hereinafter the “Final Action”), the Examiner rejected claims 57-74 and 90 (all pending claims) under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,859,967 to Kaufeld (hereinafter “Kaufeld”).

Claim 57 recites “a converter circuit [at the intermediate station] adapted . . . to convert said transmission to electronic form if said transmitted information is not initially in electronic form.” In the Final Action, the Examiner points to Kaufeld, at col. 3 line 31-col. 4 line 28, to satisfy this element. *See* Final Action, paragraph 4. To further support the rejection, the Examiner opines:

“the phrase ‘in electronic form’ is being interpreted as being in a format of ‘in facsimile form.’ With this, Kaufeld can be seen as teaching of receiving transmitted information and converting the transmission to electronic form (interpreted as a facsimile form) if the transmitted information is not initially in electronic form, whereby the received transmitted information is an electronic mail that is converted into a facsimile. The received electronic mail is not in a facsimile format, thus can be seen as being ‘not initially in electronic form.’” *Id.* (emphasis added).

Appellant respectfully disagrees with the Examiner’s interpretation of “electronic form.” As shown in the excerpt above, the Examiner has rewritten the express element “electronic” to be “facsimile,” to the exclusion of other electronic forms. Any interpretation of “electronic form” that excludes something in electronic form, such as electronic mail, is clearly improper. *See* M.P.E.P. 2111.01. As such, the rationale supporting the Examiner’s rejection is erroneous.

Further, the cited passage of Kaufeld does not teach or suggest a converter circuit adapted to convert a transmission to electronic form if the transmitted information is not initially in electronic form, nor does it describe the transmitted information being in any form other than e-mail (electronic). *See* Kaufeld col. 3 lines 33-39. Therefore, Kaufeld does not

teach the identical invention in as complete detail as is contained in the claim. Accordingly, Appellant respectfully requests withdrawal of the 35 U.S.C. § 102(e) rejection of record.

Claim 57 also recites “wherein said reproducing circuit [at the intermediate station] also produces an indicia of payment authorizing delivery of said human readable information to said selected location.” In the Final Action, the Examiner points to Kaufeld, at Figs. 1 & 2 and col. 5 lines 5-67, to satisfy this claim element. *See* Final Action, paragraph 3. In further support of his rejection, the Examiner opines:

“Kaufeld teaches of an intermediate station, being the computer 26..., whereby the computer 26 includes a fax board 66 and a printer 60, which is interpreted as a reproducing circuit adapted to reproduce received information in human readable form. Further, Kaufeld teaches that the fax board 66 or the printer 60 can be used to generate stamps, which will later be used for subsequent transmission of the received data....” *Id.*

Contrary to the Examiner’s assertion, Kaufeld does not disclose a reproducing circuit at the intermediate station that reproduces the transmitted information in human readable form and that also produces an indicia of payment authorizing delivery of said human readable information to the selected location. The computer of Kaufeld relied upon as the intermediate station by the Examiner does not reproduce the transmitted data in human readable form. *See e.g.* col. 5, lines 26-28 and col. 7, lines 6-8.

Moreover, the stamps disclosed in Kaufeld are not generated by a reproducing circuit of the intermediate station, but rather are generated by a registration process and provided to a user for inclusion in an e-mail transmitted from the transmitting location to the intermediate location. *See e.g.* col. 5, lines 1-8 and col. 6, lines 7-11. This is further supported by Kaufeld, at Fig. 3, which shows that stamps are generated immediately after creating a user account and immediately before sending the stamps to the user, during the registration process.

Furthermore, Kaufeld discloses “the stamp included in line 16 [of the facsimile] was deleted from the message and is not included in the facsimile transmission.” *See* col. 7 lines 22-25 (emphasis added). Kaufeld’s system removes the stamp from the facsimile message transmitted from computer 26, and therefore fax board 66 and printer 60, whether “interpreted as a reproducing circuit” or not by the Examiner, cannot be read to “produce[] an

indicia of payment authorizing delivery of said human readable information to said selected location” as set forth in the claim.

As shown above, Kaufeld does not teach the identical invention in as complete detail as is contained in the claim. Accordingly, Appellant respectfully requests withdrawal of the 35 U.S.C. § 102(e) rejection of record.

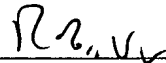
Claims 58-74 and 90 depend either directly or indirectly from, and inherit all of the elements of, independent claim 57. As shown above, claim 57 is allowable over the applied art. Therefore, claims 58-74 and 90 are allowable, at least, because of their dependence from claim 57. Accordingly, Appellant respectfully requests withdrawal of the 35 U.S.C. § 102(e) rejection of record.

III. Conclusion

Appellant respectfully traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. The fees required under 37 C.F.R. § 41.20(b)(2) are dealt with in the accompanying transmittal. If any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 61135/P012US/10105074 from which the undersigned is authorized to draw.

Dated: May 4, 2006

Respectfully submitted,

By  _____

R. Ross Viguet

Registration No.: 42,203

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-8000

(214) 855-8200 (Fax)

Attorney for Applicant